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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/735,401 | 12/12/2000 | Eckhard Alt | IFD/046 | 4641 |
| 490 | 7590 | 03/29/2006 | | |
| VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185 | | | EXAMINER THALER, MICHAEL H | |
| | | | ART UNIT. 3731 | PAPER NUMBER |

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,401

Applicant(s)

ALT, ECKHARD

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61,64,65 and 68-88 is/are pending in the application.
- 4a) Of the above claim(s) 83 and 84 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 65,68,76-82 and 88 is/are allowed.
- 6) ☒ Claim(s) 61,64,69-75 and 85-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 83 and 84 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

Claims 61, 64, 69-75, 86 and 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 61 is confusing and inaccurate since each serpentine band has only a single serpentine strut as indicated on page 27, lines 1-3. It is unclear if the struts defined in line 4 are the same as the struts defined in line 6. Claim 86 is indefinite for the same reasons. Further, it is unclear if the bands defined in line 2 are the same as the bands defined in line 6. In claim 64, line 1, there is no antecedent basis for "The stent of claim 61". Other claims are indefinite for the same reason.

Claims 61, 64, 69-75, 86 and 87 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Purdy et al. (5,562,729). Purdy et al., in figure 24, disclose a prosthesis having a plurality of serpentine bands (band 110 and the band which overlies band 110 and which, at least in part, forms struts 150) which is inherently expandable since it is resilient as indicated in col. 8, line 36, which inherently maintains the patency of a bodily

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vessel since it supports it, and struts 150, which in a cross-section perpendicular to the flowpath have thicker portions (shown in the strut 150 closest to the viewer of the figure as being on the left and right portions of the strut and measured in a radial direction of the stent) with a narrower portion therebetween (due to the space which receives members 110 and 128) and have a greater width (as measured in a circumferential direction of the stent) than thickness (as measured in a radial direction of the stent). Alternatively, it would have been obvious that the Purdy et al. prosthesis maintains the patency of a bodily vessel since it supports it. As to claim 64, struts 150 have a serpentine configuration since they undulate up and down as they extend circumferentially around the stent. As to claims 69 and 71, the Purdy et al. bands are connected to one another via connector (the biocompatible material which immediately surrounds band 110 to embed band 110 therein and which is described in col. 8, lines 45-47 and which is shown in figure 20 and 24). As to claim 72, stent 102 has a taper near the top of struts 150 as seen in figure 24. As to claim 74, the outer diameter has a taper shown in figures 22 and 25 due to the recess (best shown in figure 22) which reduces the outer diameter in that area. As to claim 86, the stent (the prosthesis identified above) is open at both ends before the

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leaves 104 are attached thereto and even after the leaves are so attached when the leaves 104 open. Alternatively, it would have been obvious that stent is open at both ends for these reasons.

Claim 85 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 5,843,117. Although the conflicting claims are not identical, they are not patentably distinct from each other because the slight difference in the wording of the claims involves only an obvious difference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 65, 68, 76-82 and 88 are allowed.

Claim 85 is free of any rejection based upon the prior art of record.

Applicant's arguments filed Jan. 11, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

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Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
3/20/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731